



Practitioner's Docket No. U 013169-9

PATENT

DEF & REF
807

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Gershon BAR-ON, et al.

Application No.: 09/376,384

Group No.: 2136

Filed: August 16, 1999

Examiner: Hoffman, Brandon S.

For: PROTECTION OF DATA ON MEDIA RECORDING DISKS

[] Patent*: Issued:

*NOTE: Insert name(s) of inventor(s) and title also for patent. Where request is with respect to a maintenance fee payment also insert application number and filing date and add Box M. Fee to address.

Mail Stop 16

Director of the United States Patent and Trademark Office

P. O. Box 1450

Alexandria, VA 22313-1450

ATTENTION: Refund Section, Accounting Division, Office of Finance

REQUEST FOR REFUND (IMPROPER CHARGE OF DEPOSIT ACCOUNT)

NOTE: 37 C.F.R. § 1.26(b) "Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based on such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable."

I. REFUND REQUEST

This is a request for a refund, with respect to the charge to Deposit Account 12-0425, shown on the statement dated January 31, 2005, for the above-identified

[x] application.
[] patent.

(check the following, if desired, and supply copy of statement)

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. SECTION 1.8(a))

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- ☒ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Director of the United States Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450.

FACSIMILE

- ☐ transmitted by facsimile to the Patent and Trademark Office to (703) 872-9306.

Signature

Date: March 7, 2005

WILLIAM R. EVANS

(type or print name of person certifying)

- ☒ A copy of the monthly statement, in which the error referred to occurs, accompanies this request.

II. FEES CHARGED FOR WHICH REFUND REQUESTED

	AMOUNT OF REFUND REQUESTED
<input type="checkbox"/> Filing fee	_____
<input type="checkbox"/> Surcharge for filing the basic filing fee on a date later than the filing date of the application (37 C.F.R. section 1.16(e))	_____
<i>and/or</i>	
<input type="checkbox"/> Surcharge for filing the oath or declaration on a date later than the filing date of the application (37 C.F.R. section 1.16(e))	_____
<input checked="" type="checkbox"/> Extension of term	_____
<input type="checkbox"/> first month	_____
<input type="checkbox"/> second month	_____
<input checked="" type="checkbox"/> third month	_____
<input type="checkbox"/> fourth month	1020.00
<input type="checkbox"/> fifth month	_____
<input type="checkbox"/> Excess claims	_____
<input type="checkbox"/> Issue fee	_____
<input type="checkbox"/> Petition fee	_____
<input type="checkbox"/> Patent maintenance fee	_____
<input type="checkbox"/> first maintenance fee	_____
<input type="checkbox"/> second maintenance fee	_____
<input type="checkbox"/> third maintenance fee	_____
<input type="checkbox"/> Patent maintenance fee surcharge	_____
<input checked="" type="checkbox"/> Other <u>Notice of Appeal</u>	500.00
_____	_____
_____	_____
_____	_____
TOTAL REFUND REQUESTED	1520.00

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III. EXPLANATION OF WHY CONTESTED CHARGE IS IN ERROR

As indicated on page 2 of the Official Action of February 9, 2005 (copy attached), the Official Action of July 19, 2004 was a Non-Final Official Action. However, it was erroneously designated by the Patent Office in the Office Action Summary as FINAL.

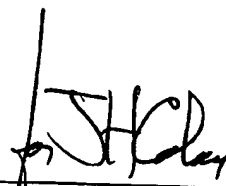
Applicants filed a response to the Official Action of July 19, 2004 on November 12, 2004. Applicants were misguided by the erroneous FINAL designation of the Office Action Summary of the Official Action of July 19, 2004, and filed a Notice of Appeal on three-month extension of time on January 19, 2005 because the Examiner had still not acted on the response filed to the Official Action. Since the Official Action was not a final rejection, submission of a Notice of Appeal was redundant and no payment of extension fees was required.

Since the Notice of Appeal and the three-month extension of time fees were paid by mistake due to Patent Office's errors in designating the Non-Final Official Action of July 19, 2004 as FINAL, and not due to a change of purpose after the payment of the fees, it is respectfully requested that these fees be refunded to Deposit Account No. 12-0425.

IV. MANNER OF REFUND

Please make refund by

- ☒ crediting Account No. 12-0425.
☐ refunding payment.

Exp. 25,854 

SIGNATURE OF PRACTITIONER

JULIAN H. COHEN

(type or print name of practitioner)

Reg. No. 20,302

Tel. No. (212) 708-1887

Customer No. 00140

P.O. Address

c/o Ladas & Parry LLP
26 West 61st Street
New York, N.Y. 10023



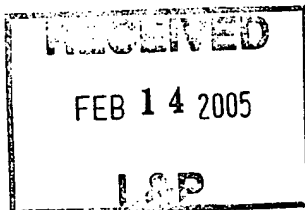
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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/376,384	08/16/1999	GERSHON BAR-ON	U013169-9	6449

140 7590 02/09/2005

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NY 10023



EXAMINER
HOFFMAN, BRANDON S

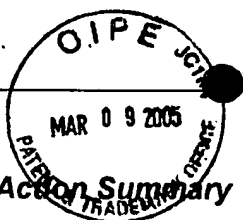
ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 02/09/2005

5/9/05 R.D. JK
6/9/05 1m
7/9/05 2m EXT
8/9/05 3m

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/376,384

Applicant(s)

BAR-ON, GERSHON

Examiner

Brandon S Hoffman

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 78,80-82 and 84-86 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 78,80-82 and 84-86 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/29/04
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____



DETAILED ACTION

Miscellaneous Matters

This action is being sent in response to the amendment filed November 12, 2004. The previous office action, mailed on July 19, 2004, was meant to be a Non-Final Office Action—even though the Office Action Summary (form PTO-326) indicated a Final Office Action. Because of this, applicant was in a position of replying to a Final Office action, thus requiring more stringent time and money restrictions. This action is meant to clarify the record that the previously sent office action was a Non-Final action. Therefore, the After-Final response should instead be a response to Non-Final Action.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 78, 80, 81, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moos (U.S. Patent No. 5,881,152).

Regarding claim 78, Moos teaches a method for protecting access to content recorded on a media recording disk (DVD), comprising:

- Providing a disk security chip on the DVD, said disk security chip managing access to the content of the DVD (col. 1, line 66 through col. 2, line 3);

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01/21 411 10404055	U-014900-6	8021	\$40.00	\$8,519.15
01/21 1258 78550617	NY-1T04419672	7001	\$335.00	\$8,178.15
01/21 3213 1880679	TM NY-19301487-9 : TUR	7205	\$100.00	\$8,078.15
01/21 3214 1880679	NY-19301487-9 : TUR	7201	\$400.00	\$7,678.15
01/21 3244 1005274	NY-17305186-7 : TUR	7205	\$100.00	\$7,578.15
01/21 3245 1005274	NY-17305186-7 : TUR	7201	\$400.00	\$7,178.15
01/24 22 29214260		9204	-\$75.00	\$7,253.15
01/24 26 E-REPLENISHMENT		9203	-\$10,000.00	\$17,253.15
01/24 158 76492615		8521	\$40.00	\$17,213.15
01/24 159 76492611		8522	\$25.00	\$17,188.15
01/24 160 2782478		8522	\$25.00	\$17,163.15
01/24 161 2787086		8522	\$25.00	\$17,138.15
01/24 179 1372867	TM NY-29303342-2 : TUR	7205	\$100.00	\$17,038.15
01/24 180 1372867	NY-29303342-2 : TUR	7201	\$400.00	\$16,638.15
01/24 231 1023482	NY-29502140-9 : TUR	7205	\$100.00	\$16,538.15
01/24 232 1023482	NY-29502140-9 : TUR	7201	\$400.00	\$16,138.15
01/25 6 09630333	U-012799-1	1202	-\$432.00	\$16,570.15
01/25 45 10931812	U 015358-6	1001	\$790.00	\$15,780.15
01/25 46 10931812	U 015358-6	1051	\$130.00	\$15,650.15
01/25 47 10931812	U 015358-6	1053	\$130.00	\$15,520.15
01/25 48 10736206	U014941-4	2252	\$225.00	\$15,295.15
01/25 49 09376384	U 013169-9 NY APP.	1401	\$500.00	\$14,795.15
01/25 50 09376384	U 013169-9 3rd. 1253	1253	\$1,020.00	\$13,775.15
01/25 51 10455255	U-014653-9	2251	\$60.00	\$13,715.15
01/25 244 78552786	1T05420417	7001	\$335.00	\$13,380.15
01/25 269 1316858	NY-20202067-5 : TUR	7205	\$100.00	\$13,280.15
01/25 270 1316858	NY-20202067-5 : TUR	7201	\$400.00	\$12,880.15
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01/26 1 78553475	NY-1T05420431	7001	\$335.00	\$12,210.15
01/26 2 PCT/US02/02900		9204	-\$7.00	\$12,217.15
01/26 2 29214260	UD 051584-3	2002	\$75.00	\$12,142.15
01/26 357 60542088		8007	\$20.00	\$12,122.15
01/26 358 60542088		8007	\$20.00	\$12,102.15
01/26 502 10931812		8021	\$40.00	\$12,062.15
01/26 635 10484054		8021	\$40.00	\$12,022.15
01/27 27 10978569	U 015438-8	2202	\$108.00	\$11,914.15
01/28 6 10838531	U 015173-4	9204	-\$240.00	\$12,154.15
01/28 1175 1007395	NY-20102160-8 : TUR	7205	\$100.00	\$12,054.15
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01/28 1241 1326816	NY-20202066-4 : TUR	7201	\$400.00	\$11,154.15
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01/28 1323 2296242	NY-19402680-6 : TUR	7208	\$200.00	\$10,854.15
01/28 1384 1358472	NY-29702087-1 : TUR	7205	\$100.00	\$10,754.15
01/28 1385 1358472	NY-29702087-1 : TUR	7201	\$400.00	\$10,354.15
01/31 2 10736206	U014941-4	2202	\$150.00	\$10,204.15
01/31 8 2250993	NY-19701244-4 : TUR	7205	\$100.00	\$10,104.15
01/31 9 2250993	NY-19701244-4 : TUR	7208	\$200.00	\$9,904.15
01/31 37 10613532	U014701-4	1001	-\$640.00	\$10,544.15
01/31 39 10613532	U014701-4	1051	-\$130.00	\$10,674.15
01/31 242 78556032	NY-1T05420456 : TUF	7001	\$335.00	\$10,339.15
01/31 1202 78556649	NY-1T05420331	7001	\$325.00	\$10,014.15

AF 2131 \$



Practitioner's Docket No. U 013169-9

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Gershon BAR-ON
Serial No.: 09/376,384 Group No.: 2131
Filed: August 16, 1999 Examiner: James Seal
For: PROTECTION OF DATA ON MEDIA RECODING DISKS

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

NOTICE OF APPEAL FROM THE PRIMARY EXAMINER
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
(37 C.F.R. 1.191)

NOTE: An appeal may be based on one rejection in a prior application and one rejection in a continuing application. Notice of Oct. 10, 1997, 62 F.R. 53131, at 53167.

NOTE: There is no requirement for a notice of appeal to: (1) be signed; or (2) identify the appealed claims. Notice of Oct. 10, 1997, 62 F.R. 53131, at 53167.

Applicant hereby appeals to the Board from the decision of the Primary Examiner, mailed July 19, 2004, finally rejecting claims 52-78, 80-86 and 88-95.

The item(s) checked below are appropriate:

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. 1.8(a))

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Date: January 19, 2005

FACSIMILE

- ☐ transmitted by facsimile to the Patent and Trademark Office, to (703) 872-9306

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

11/25/2005 YPOLITE1 00000039 120425 09376384

11 FC:1401 500.00 DA

11/25/2005 YPOLITE1 00000039 120425 09376384

12 FC:1253 1020.00 DA

(Notice of Appeal from the Primary Examiner to Board—page 1 of 4)

Adjustment Date: 05/13/2005
01/25/2005 YPOLITE1 00000039 120425 09376384
01 FC:1401 500.00 CR
02 FC:1253 1020.00 CR

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